

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Paul Phillip Van Saarloos
Serial No. : 09/719,726
Filed : December 15, 2000
For : Z AXIS TRACKER

RENEWED PETITION UNDER 37 C.F.R. 1.47(b)

I hereby certify that this paper is being deposited
with the United States Postal Service as first class mail in
an envelope addressed to: Assistant Commissioner for
Patents, BOX PCT, Washington, D.C. 20231

June 7, 2002
Date of Deposit

Richard G. Berkley
Attorney Name

25,465
PTO Registration No


Signature

June 7, 2002
Date of Signature

Attention: PCT Legal Office

Assistant Commissioner for Patents
BOX PCT
Washington, D.C. 20231

Sir:

This is in response to the Decision Refusing Status Under 37 C.F.R. 1.47 dated December
10, 2001 in the above-identified application. Concurrently herewith the Rule 47(b) applicant has

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submitted a request and the appropriate small entity fee (\$720) for a four-month extension of the period for response to the Decision from February 10, 2002 and including June 10, 2002.

Applicant's petition under 37 C.F.R. 1.47(b) was dismissed, without prejudice, on the grounds (1) that the showing of proprietary interest in the invention by the Rule 47(b) applicant (The Lions Eye Institute of Western Australia Incorporated) was insufficient, because the submitted employment agreements between Dr. Van Saarloos and the Rule 47(b) applicant did not clearly establish that the invention of the present application was made by Dr. Van Saarloos during his employment by the applicant, and (2) that the showing of Dr. Van Saarloos' refusal to sign the application papers was deficient, because there was no showing that Dr. Van Saarloos was presented with the complete application (specification, claims, drawings and oath or declaration) prior to the refusal.

To overcome the foregoing alleged deficiencies in the Rule 47(b) petition, applicant submits herewith the following documents:

(1) a Statement Establishing Proprietary Interest By Person Signing On Behalf Of Nonsigning Inventor, by Ian Jeffrey Constable; and

(2) a Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor, by Gregory Joseph Noonan.

In the Statement Establishing Proprietary Interest, Mr. Constable attests that he is a person with firsthand knowledge of the circumstances in which The Lions Eye Institute came into possession of the invention of the present application (See ¶5), and that such invention was made by Dr. Van Saarloos while he was employed by The Lions Eye Institute. (See ¶6).

Mr. Constable also attests that Dr. Van Saarloos was intimately familiar with the content of the instant application. (See ¶7).

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In the aforementioned Statement of Facts, Mr. Noonan, a registered patent attorney in Australia, states that he was appointed by The Lions Eye Institute to handle, inter alia, the filing of international patent application PCT/AU99/00479, of which the present application is the United States national phase counterpart. By virtue of his personal experience with Dr. Van Saarloos in the course of preparing the international application, Mr. Noonan attests on firsthand knowledge that Dr. Van Saarloos was familiar with the content of the international application and, therefore, of the present United States application at the times Dr. Van Saarloos was forwarded the U.S. application papers for signature. (See ¶'s 1-6).

In addition, Mr. Noonan attests that, on May 21, 2002, he sent an Assignment and a Combined Declaration and Power of Attorney, with attached specification, claims and drawings, to Dr. Van Saarloos' Australian counsel, with the request that the application papers be signed by Dr. Van Saarloos and returned by June 3, 2002 for filing in the U.S. Patent Office by June 10, 2002. (See ¶ 7 and Exhibits 1 and 2).

Mr. Noonan has further attested that he followed up his letter of May 21, 2002 by repeated telephone calls to Dr. Van Saarloos' counsel, that counsel informed on June 6, 2002 that the application papers had been promptly forwarded to Dr. Van Saarloos and had been acknowledged by him, but that Dr. Van Saarloos had left for the United States without executing the papers and would not return until later in June. Mr. Noonan was advised by Dr. Van Saarloos' counsel that, although Dr. Van Saarloos was not refusing absolutely to sign the application papers, he had refused to sign and return the Declaration prior to his departure. (See ¶8).

In view of the foregoing factual showings, we respectfully submit that the Rule 47(b) applicant has established both a sufficient proprietary interest in the subject matter of the present

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application and that Dr. Van Saarloos' conduct constitutes a clear refusal to execute the application. Reconsideration and withdrawal of the denial of applicant's Rule 47(b) petition are therefore respectfully requested.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 02-4377. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Richard G. Berkley", is written over a horizontal line.

Richard G. Berkley
PTO Reg. No. 25,465
Attorney for Applicant

Baker Botts L.L.P.
30 Rockefeller Plaza
New York, NY 10112
Tel: 212-408-2554
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Paul Phillip Van Saarloos
Serial No. : 09/719,726
Filed : December 15, 2000
For : "Z Axis Tracker"

STATEMENT ESTABLISHING PROPRIETARY INTEREST BY PERSON SIGNING
ON BEHALF OF NONSIGNING INVENTOR

1. I, Ian Jeffrey Constable, residing at 134 Glyde Street, Mosman Park, Western Australia, 6012, Australia

am the person signing the Declaration of the above-identified application on behalf of the non-signing inventor and make this statement as to the facts establishing proprietary interest.

2. As of the date I signed the Declaration for this application, the proprietary interest in this invention belonged to the following juristic person:

The Lions Eye Institute of Western Australia Incorporated
2 Verdun Street
Nedlands, Western Australia 6009

3. I am authorized to sign the statement on behalf of the juristic person, my title being Director of The Lions Eye Institute of Western Australia Incorporated.

4. I signed an earlier statement in this matter dated 27 July 2001, being a Statement Establishing Proprietary Interest by Person Signed on behalf of Non-signing Inventor.

5. I have firsthand knowledge of the circumstances in which The Lions Eye Institute of Western Australia Incorporated came into possession of the invention which is the subject of US patent application 09/719,726, and arranged filing of the original Australian provisional patent application PP4202 and of international patent application PCT/AU99/00479.

6. The invention which is the subject of US patent application 09/719,726 was made by Paul Phillip Van Saarloos, the named inventor in the application, while he was employed by The Lions Eye Institute of Western Australia Incorporated.

7. At the time of filing international patent application PCT/AU99/00479 Paul Phillip Van Saarloos was not only sole named inventor in the application, but was also responsible for managing the patent applications of The Lions Eye Institute of Western Australia Incorporated, and for instructing the Institute's patent attorneys. He was intimately familiar with the contents of international patent application PCT/AU99/00479 and therefore of the subsequent US national phase application 09/719,726

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such wilful false statements may jeopardize the validity of the application or my patent issued thereon.

Date:

6 / June / 02

Ian Jeffrey Constable

Ian Jeffrey Constable

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Paul Phillip Van Saarloos
Serial No. : 09/719,726
Filed : December 15, 2000
For : "Z Axis Tracker"

STATEMENT OF FACTS IN SUPPORT OF FILING
ON BEHALF OF NONSIGNING INVENTOR (37 C.F.R. §1.47(b))

I, Gregory Joseph Noonan, residing at 18 Somers Avenue, Malvern, Victoria, 3144, Australia, state:

1. I am a registered patent attorney in Australia, and a partner of Freehills Carter Smith Beadle (patent and trade mark attorneys), of 101 Collins Street, Melbourne, Victoria, Australia.

2. I was appointed by The Lions Eye Institute of Western Australia Incorporated, [the Institute] in early 1999, to handle a number of its patent application files. On behalf of the Institute I arranged the filing of international patent application PCT/AU99/00479, on 17 June 1999. Subsequently, I arranged, through US patent attorneys, the filing of the counterpart US national phase application, assigned the serial number 09/719,726.

3. I have reviewed the Statement of Facts in these proceedings by Ian Jeffrey Constable dated 27 July 2001 and in particular exhibits 1 and 7. I have further reviewed my files and discussed the matter with Jeanette Butler, who is mentioned in the aforesaid Statement of Facts dated 27 July 2001. We have agreed that it is uncertain as to whether the US application papers forwarded to Dr Paul Van Saarloos for signature in connection with US patent application 09/719,726 were accompanied by a copy of the specification, claims and drawings.

4. However, I am aware that Dr Van Saarloos was fully informed and knowledgeable as to the content of US patent application 09/719,726. During the period from early 1999 to about May 2000, Dr Van Saarloos was the officer of the Institute responsible for managing the Institute's patent matters that I was handling and so he generally reviewed and had significant input to draft patent applications and proposed amendments.

5. I have examined my files in connection with international patent application PCT/AU99/00479 and find that Dr Van Saarloos reviewed the draft specification sent to him in June 1999, and commented in detail with a number of suggested amendments. The international application was not amended during the international phase.

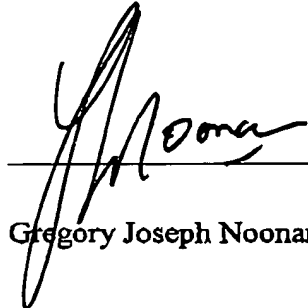
6. It is therefore clear to me that, at the times he was forwarded the US application papers for signature, Dr Van Saarloos was familiar with the content of the international patent application and therefore also of the US national phase application. The US application papers did not refer to the specification as being attached.

7. On 21 May 2002, I wrote to Mr Mark Dwyer, of Corrs Chambers Westgarth, Dr Van Saarloos' lawyers, requesting Dr Van Saarloos' signature on an assignment and a combined declaration and power of attorney ("the forms"). A copy of this letter is appended as Exhibit 1. Copies of the registered mail receipt and an email acknowledgment from Mr Dwyer are appended as Exhibit 2. I wrote to Mr Dwyer because legal proceedings between the parties are continuing.

8. Mr Dwyer called me on 6 June 2002, in response to three earlier telephone calls from me, and informed me that (i) he had promptly sent the forms to Dr Van Saarloos and Dr Van Saarloos had confirmed receipt, (ii) Dr Van Saarloos left for the United States a few days ago with the forms in his possession and would not return to Australia until later this month, and (iii) Dr Van Saarloos was not refusing absolutely to sign the form but had refused to sign and return the form before his departure.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such wilful false statements may jeopardize the validity of the application or my patent issued thereon.

Date:

7 June 2002

Gregory Joseph Noonan

Exhibit 1

Freehills

Carter Smith Beadle

21 May 2002

Our ref M40463811:GJN:JLM
Phone (03)9288 1578
Email greg_noonan@freehills.com.au

Doc no Melbourne\004055601

Mr Mark Dwyer
Corrs Chambers Westgarth
GPO Box 9925
PERTH WA 6001

By Registered Mail

Dear Mr Dwyer

The Lions Eye Institute of Western Australia Incorporated
United States patent application no. 09/719726
Z axis tracker

We are patent attorneys acting for The Lions Eye Institute of Western Australia Incorporated in relation to this matter.

On several occasions during 2001, you and your client Dr Paul Van Saarloos were asked for Dr Van Saarloos' signature on papers connected with the above-referenced patent application.

We now attach copies of the following two papers and ask again that Dr Van Saarloos sign the documents where tagged and return them to us by Monday 3 June 2002 at the latest. We must file paper (2) in the US Patent Office by 10 June 2002.

- 1 Assignment
- 2 Combined Declaration and Power of Attorney with attached specification, claims and drawings.

A lack of response from you by 3 June 2002 will be taken to constitute a refusal by Dr Van Saarloos to sign paper (2) above.

If Dr Van Saarloos' present concern is confined to paper (1), we will be pleased to receive paper (2) only by 3 June 2002. This will ensure ongoing regularisation of the US application. The assignment can be filed later.

If you or Dr Van Saarloos have any questions concerning these documents, please do not hesitate to call.

Yours faithfully
Freehills Carter Smith Beadle

Greg Noonan
Partner

Enc.

Patent & Trade Mark Attorneys

101 Collins Street Melbourne Vic 3000 Australia
GPO Box 128A Melbourne Vic 3001 Australia

Telephone 61 3 9288 1577 Facsimile 61 3 9288 1567
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Offices in SYDNEY MELBOURNE Registered Patent Attorneys in Australia & New Zealand

Exhibit 2



Mark_Dwyer@corrs.com.au

To: Greg_noonan@freehills.com.au

23/05/2002 14:08

cc: Subject: LEI - Z axis tracker

US

40463811

Dear Sir,

We have received your letter to us dated 21 May 2002 together with the enclosures

We will obtain our client's instructions and revert to you as soon as possible.

Regards.

This e-mail and any attachments may be confidential. You must not disclose or use the information contained in this e-mail if you are not the intended recipient. If you have received this e-mail in error, please notify us immediately and delete the e-mail and all copies. Corrs does not guarantee that this e-mail is virus or error free. The attached files are provided and may only be used on the basis that the user assumes all responsibility for any loss, damage or consequence resulting directly or indirectly from the use of the attached files, whether caused by the negligence of the sender or not. Corrs is not responsible for any changes made to a document other than those made by Corrs, or for the effect of any changes (not made by Corrs) on a document's meaning. The content and opinions in non-business e-mail are not necessarily those of Corrs.

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